# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/942,978 | 08/31/2001 | Ken Kutaragi | 100809-16279 (SCEW 18.968 | 7677 |

| | | | EXAMINER |
|---|---|---|---|
| 26304 | 7590 | 02/03/2009 | VAN HANDEL, MICHAEL P |

KATTEN MUCHIN ROSENMAN LLP
575 MADISON AVENUE
NEW YORK, NY 10022-2585

| ART UNIT | PAPER NUMBER |
|---|---|
| 2424 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 02/03/2009 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/942,978 | KUTARAGI ET AL. |
| | Examiner | Art Unit | |
| | MICHAEL VAN HANDEL | 2424 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☒ Responsive to communication(s) filed on *20 November 2008*.

2a)☒ This action is **FINAL**.　　　2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☒ All　b)☐ Some *　c)☐ None of:

　　　1.☒ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

## DETAILED ACTION

### *Response to Amendment*

1.      This action is responsive to an Amendment filed 11/20/2008.  Claims **1-8** are pending.

Claims **1**, **2**, **4**, **6**, **7** are amended.  Claims **9-12** are canceled.

### *Response to Arguments*

1.      Applicant's arguments regarding claims **1**, **2**, **4**, **6**, and **7**, filed 11/20/2008, have been

fully considered, but they are not persuasive.

       Regarding claims **1**, **2**, **4**, **6**, and **7**, the applicant argues that Stefik et al.'s metering usage

rights attached to a digital work does not meet the claimed feature of digital information itself,

which is embedded in content, providing functionality to a user terminal to, say, monitor and

store utilizing history.  The examiner respectfully disagrees.  The applicant specifically argues

that this is merely a simple causation and that the usage rights of Stefik et al. do not themselves

include any functionality, but merely provide bases for call functions already defined in the

entities that refer to those usage rights for performing functions according to parameters defined

in the usage rights.

       As noted in the Office Action mailed 8/20/2008, Stefik et al. discloses attaching metering

rights to a digital work (col. 10, l. 58-64; col. 22, l. 51-56; col. 23, l. 13-26; col. 25, l. 35-38; &

col. 26, l. 61-65).  An End-charges transaction ends a charge for metered use.  A report-charges

transaction between a personal credit server and a billing clearinghouse is invoked at least once

per billing period, and is used to pass along information about charges (col. 31, l. 26-40).  The

examiner notes that the metering rights do provide functionality to the credit server to
autonomously monitor the utilization of contents, because the clock in the credit server would
not monitor the time usage of contents if metered usage rights were not set.  Applicant
specifically argues that Stefik et al. at most describes usage rights as parameters defining how the
digital work may be used or further distributed as enforced by the secure functionality provided
by the serving and requesting repositories and argues that Stefik et al. merely provide bases for
call functions already defined in the repositories.  As noted in the examiner's remarks in the
Office Action mailed 8/20/2008, these usage rights "function" to call these functions and further
"function" to cause the metering and clock functions to occur in the credit server.  As such, the
examiner maintains that the metering rights of Stefik et al. include functionality provided to the
user terminal, as currently claimed.

Further regarding claims **1**, **2**, **4**, **6**, and **7**, the applicant argues that Stefik et al. only
describes discrete processing for a particular digital work being requested per transaction, and,
thus clearly fails to disclose the claimed features of processing a plurality of contents, in each of
which digital information is embedded, to one archive data, encrypting the archive data and
adding an attribute data to the archive data, distributing the archive data and attribute data, and
identifying, counting, and billing for the contents thus distributed.  The examiner respectfully
disagrees.  Stefik et al. discloses a fee accounting system where creators create digital works and
determine appropriate usage rights and fees, which they attach to the digital work (col. 7, l. 7-
10).  Other creators and distributors utilize this work in combination with other works to create
composite works (col. 6, l. 40-42).  The structure of these digital works is organized as a
hierarchy of nodes of works (col. 9, l. 8-13).  Usage rights are placed on each node by its creator,

so that the creator of a work can be assured that the rights and fees are not circumvented (col. 9,

l. 16-20).  Figures 5 and 6 illustrate the hierarchy of a composite digital work (col. 9, l. 50-52 &

Figs. 5, 6).  The description tree for a digital work is comprised of a set of related descriptor

blocks (d-blocks), each of which specifies the granted usage rights of its corresponding node

(col. 9, l. 50-67).  A special type of d-block is a "shell" d-block.  A shell d-block adds no new

content beyond the content of its parts and is used to add rights and fee information, typically by

distributors of digital works (col. 10, l. 8-11 & Figs. 8, 9).  For example, in an Embed

transaction, a creator or distributor makes a digital work become a part of another digital work

or adds a shell d-block to enable the adding of fees by a distributor of the work.  The rights of the

original work and all of its parts are updated and transmitted to the requestor (col. 11, l. 58-67;

col. 12, l. 1-40; col. 41, l. 53-67 & col. 42, l. 1-15).  A similar example exists in the case of Paid

Distributors, which may add a shell with fees to a composite work to ensure that fees be paid

back to the distributor (col. 45, l. 45-67).  Since Stefik et al. describes that a creator or distributor

may embed further content to a composite work and add usage rights, the examiner maintains

that Stefik et al. meets the limitations of "processing a plurality of contents, in each of which the

digital information is embedded, to one archive data," "encrypting said archive data and adding

an attribute to the archive data," and "distributing said archive data and attribute data through a

predetermined distribution mechanism," as currently claimed.


### *Claim Rejections - 35 USC § 102*

1.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2.      Claims **1**, **6** are rejected under 35 U.S.C. 102(b) as being anticipated by Stefik et al.

Referring to claims **1** and **6**, Stefik et al. discloses a method/system for managing fees of contents in which the fees arise based on a predetermined charging rule upon distributing the contents (col. 4, l. 4-10), said method/system comprising the steps of:

- equipping information gathering means on a network (Billing Clearinghouse) with which a user terminal (computer system) is allowed to connect (col. 7, l. 5-37), said user terminal carrying out information processing by utilizing said contents (col. 7, l. 66-67; col. 8, l. 1-18, 57-67; col. 9, l. 1-5; & Figs. 3, 4b);

- embedding digital information to said contents (col. 7, l. 7-10; col. 10, l. 8-11; & col. 11, l. 44-52), said digital information itself including functionality provided to said user terminal to autonomously monitor, and store, a contents utilizing history at the user terminal (col. 22, l. 51-56; col. 23, l. 13-26; col. 25, l. 35-38; col. 26, l. 61-65; col. 31, l. 26-40; col. 33, l. 53-57; & col. 50, l. 26-28), and transmit the stored contents utilizing history along with identification information (col. 31, l. 16-18, 37-41) to said information gathering means at a predetermined timing while said user terminal is connected with said network (col. 8, l. 10-20, 57-67; col. 9, l. 1-5; col. 18, l. 12-45; & Fig. 3);

- processing a plurality of said contents, in each of which the digital information is embedded, to one archive data (col. 6, l. 39-42; col. 10, l. 8-11; col. 11, l. 52-55; col. 41, l. 53-67; col. 42, l. 1-15; col. 45, l. 45-67; & Figs. 8, 9);

- encrypting said archive data and adding an attribute data to the archive data (col. 9, l. 49; col. 10, l. 8-11; col. 41, l. 53-67; col. 42, l. 1-15; col. 45, l. 45-67; & Figs. 8, 9);

- distributing said archive data and attribute data through a predetermined distribution mechanism (col. 4, l. 4-8; col. 10, l. 8-11; col. 11, l. 31-56; col. 22, l. 20-27; col. 45, l. 20-67; col. 46, l. 1-67; col. 47, l. 1-67; & col. 48, l. 1-45);

- holding, by predetermined identification information holding means, identification information for identifying said distributed contents and said distribution mechanism (col. 8, l. 4-9; col. 10, l. 24-34, 45-67; col. 11, l. 1-13; col. 17, l. 48-67; & col. 18, l. 1-45);

- counting a distribution condition of contents per distribution mechanism based on said contents utilizing history gathered through said information gathering means and said identification information held by said identification information holding means (col. 10, l. 8-11, 24-34, 45-67; col. 11, l. 1-13; col. 47, l. 30-45; & Fig. 14); and

- determining a charging amount per distribution mechanism based on said counted distribution condition and a charging rule for said contents (col. 17, l. 48-60; col. 18, l. 1-45, 60-65; col. 32, l. 66-67; col. 33, l. 1-9; & col. 47, l. 30-45),

- wherein the contents utilizing history is stored permanently as long as the contents is utilized (col. 10, l. 58-65; col. 14, l. 40-44; & col. 33, l. 53-57).


### *Claim Rejections - 35 USC § 103*

1.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.      Claims **2-5**, **7**, and **8** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Stefik et al. in view of Aras et al.

Referring to claims **2**, **4**, and **7**, Stefik et al. discloses a method/system for managing fees

of contents in which the fees arise based on a predetermined charging rule upon utilizing the

contents, said method comprising the steps of:

-       issuing a recording medium to a user operating a user terminal which carries out

        information processing by utilizing said contents (col. 17, l. 31-36 & col. 18, l. 24-

        38), said recording medium having a data recording area in which user identification

        data is recorded (col. 13, l. 51-54, 59-67) and a memory area (col. 14, l. 28-39);

-       equipping information gathering means on a network with which said user terminal

        with said recording medium being loaded is allowed to connect (col. 7, l. 5-37);

-       embedding digital information to said contents, said digital information itself

        including functionality provided to said user terminal to autonomously monitor, and

        store to said memory area, a contents utilizing history indicating utilizing condition of

        the contents at the user terminal (col. 22, l. 51-56; col. 23, l. 13-26; col. 25, l. 35-38;

        col. 26, l. 61-65; col. 31, l. 26-40; col. 33, l. 53-57; & col. 50, l. 26-28), and read said

        stored contents utilizing history so as to transmit said contents utilizing history to said

        information gathering means along with said user identification data at a

        predetermined timing while said user terminal is connected with said network (col. 8,

l. 4-9, 10-20, 57-67; col. 9, l. 1-5; col. 10, l. 24-34, 45-67; col. 11, l. 1-13; col. 17, l. 48-67; col. 18, l. 1-45; & Fig. 3);

- processing a plurality of said contents, in each of which the digital information is embedded, to one archive data (col. 6, l. 39-42; col. 10, l. 8-11; col. 11, l. 52-55; col. 41, l. 53-67; col. 42, l. 1-15; col. 45, l. 45-67; & Figs. 8, 9);

- encrypting said archive data and adding an attribute data to the archive data (col. 9, l. 49; col. 10, l. 8-11; col. 41, l. 53-67; col. 42, l. 1-15; col. 45, l. 45-67; & Figs. 8, 9);

- distributing said archive data and attribute data through a predetermined distribution mechanism (col. 4, l. 4-8; col. 10, l. 8-11; col. 11, l. 31-56; col. 22, l. 20-27; col. 45, l. 20-67; col. 46, l. 1-67; col. 47, l. 1-67; & col. 48, l. 1-45);

- holding, by predetermined identification information holding means, identification information for identifying said distributed contents and said distribution mechanism (col. 8, l. 4-9; col. 10, l. 24-34, 45-67; col. 11, l. 1-13; col. 17, l. 48-67; & col. 18, l. 1-45);

- counting a utilization condition of the contents per user based on the contents utilizing history and the user identification data gathered through said information gathering means (col. 10, l. 8-11, 24-34, 45-67; col. 11, l. 1-13; col. 47, l. 30-45; & Fig. 14); and

- determining a charging amount per user based on said counted utilization condition and a charging rule for said contents (col. 17, l. 48-60; col. 18, l. 1-45, 60-65; col. 32, l. 66-67; col. 33, l. 1-9; & col. 47, l. 30-45),

- wherein the contents utilizing history is stored permanently as long as the contents is utilized (col. 10, l. 58-65; col. 14, l. 40-44; & col. 33, l. 53-57).

Stefik et al. does not specifically disclose that the memory area of the data recording area be a nonvolatile memory area. Aras et al. discloses a method and apparatus for monitoring audio-visual materials presented to a subscriber (col. 6, l. 32-52). Monitored audio-visual information is stored in a Behavior Collection Table (BCT)(col. 9, l. 2-11). The BCT table is stored to a non-volatile memory, such as a flash memory (col. 16, l. 46-49). The collected information is then sent to a Behavior Collection Center (BCC) for processing (col. 12, l. 40-54). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the memory of Stefik et al. to be a non-volatile memory, such as that taught by Aras et al. in order to retain data in a power off event (col. 16, l. 34-49).

Referring to claims **3** and **5**, the combination of Stefik et al. and Aras et al. teaches a method for managing fees of contents according to claims 2 and 4, respectively, further comprising the steps of encrypting the contents to be distributed and issuing key information for decrypting said encrypted contents, said key information being recorded in said recording medium (Stefik et al. col. 28, l. 1-37).

Referring to claim **8**, the combination of Stefik et al. and Aras et al. teaches a system for managing fees of contents according to claim 7, wherein said recording medium is a card equipped with an IC chip (col. 14, l. 7-50 & col. 17, l. 32-36), said card being individualized per user (col. 13, l. 51-67), and information indispensable for utilizing said contents is recorded in said card (col. 28, l. 28-30).

### *Conclusion*

**THIS ACTION IS MADE FINAL.**  Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action.  In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action.  In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.


Any inquiry concerning this communication or earlier communications from the

examiner should be directed to MICHAEL VAN HANDEL whose telephone number is

(571)272-5968.  The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Chris Kelley can be reached on 571-272-7331.  The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system.  Status information for published applications

may be obtained from either Private PAIR or Public PAIR.  Status information for unpublished

applications is available through Private PAIR only.  For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris  Kelley/
Supervisory Patent Examiner, Art Unit
2424

MVH